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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/331,959	09/28/1999	RAYMOND DUBOUIS	022701-831	2312

21839 7590 04/11/2006

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EXAMINER

MOORE, MARGARET G

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 04/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/331,959

Applicant(s)

DUBOUIS, RAYMOND

Examiner

Margaret G. Moore

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 to 35, 40 to 47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 to 29, 31 to 33, 40 to 47 is/are rejected.
- 7) ☒ Claim(s) 30 and 34 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/27/06, 6/30/99

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1 to 21, 26 and 45 to 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takita et al.

This rejection relies on the rationale of record. Applicants' arguments are not persuasive in overcoming this rejection.

Applicants first note that mixture B has been limited to a mixture consisting of A1 and B2. The composition itself, however, does not exclude the azo component due to the language "consisting essentially of", as noted previously. It is applicants' position that Takita does not suggest that the silicone rubber can have the required nonflammability without the addition of the azo compound. They argue that this is in contrast with their examples that have enhanced arc tracking and arc erosion resistance properties without the azo compound. This position does not overcome the prior art since it does not appear to be properly related to the issue at hand. That is, the claims add a mixture of A1 and B2 in an effective amount to enhance arc tracking and arc erosion resistance, not to render the composition non-flammable. Applicants then define what an effective amount is at the end of the claim. Note that both the platinum compound A1 and the cerium compound B2 are present in the composition of Takita et al. in amounts that meet what applicants define as "an effective amount" (column 3, line 48 and column 4, line 26). Arguments directed to the necessity of an azo compound for flame retardancy do not have any bearing on the presence of A1 and B2 in an effective amount.

As an aside, the Examiner does not agree with applicants' position that comparative example 1 in Takita has *no* nonflammability properties. See column 1 of Takita et al. that notes that the addition of platinum containing compound is known to make silicone rubber nonflammable. The fact that complete combustion occurred during the

particular test shown does not mean that the composition is nonflammable under any and all testing conditions.

Applicants then argue that "Takita disclosed silicone rubber compositions that crosslink via a peroxide catalyst". It is unclear why applicants do not acknowledge the fact that Takita also teaches that the silicone rubber composition can be cured by means of hydrosilylation on column 5, lines 3 to 10. Patentees are in no way limited to peroxide cure; they fully disclose the same cure system used by applicants. The position that it would not have been obvious to modify Takita's rubber composition that cures via a peroxide to result in a composition that cures via a hydrosilylation reaction flies in the face of the specific teachings in Takita. Arguments to this extent simply carry no weight.

3. Claims 1 – 25, 27 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP '644 in view of Matsushita.

This rejection relies on the rationale of record. Applicants' arguments are not persuasive in overcoming this rejection.

Applicants' traversal appears to be identical to that submitted in the paper dated 5/9/05 (which, as noted in the office action dated 7/27/05, is the same as the arguments previously filed). Since applicants have not provided any new arguments the Examiner relies completely on her remarks made in previous office actions in maintaining this rejection. See for instance the Examiner's Answer.

4. Claims 28, 29, 31 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cavezzan in view of JP '644.

This rejection relies on the rationale of record. Applicants' arguments are not persuasive in overcoming this rejection.

Applicants argue that the office has not established that it would have been desirable to improve the flame resistance of Cavezzan's organopolysiloxane composition. Applicants are reminded that obviousness is, in fact, determined at the level of one having ordinary skill in the art. The skilled artisan would be aware of the

benefits that are inherently associated with improved flame resistance in silicone rubbers. Elastomers and coatings such as those found in Cavezzan have many utilities in which flame resistance would be beneficial. Thus the skilled artisan would have been motivated to add known flame retarding additives to the composition of Cavezzan in an effort to obtain the known benefits and properties associated therewith.

5. Claims 33 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over McDermott et al. in view of JP '644.

This rejection relies on the rationale of record. Applicants' arguments are not persuasive in overcoming this rejection.

Applicants argue that the office has not established that it would have been desirable to improve the flame resistance of McDermott's organopolysiloxane composition. Applicants are reminded that obviousness is, in fact, determined at the level of one having ordinary skill in the art. The skilled artisan would be aware of the benefits that are inherently associated with improved flame resistance in silicone rubbers. Elastomers and coatings such as those found in Cavezzan have many utilities in which flame resistance would be beneficial. Thus the skilled artisan would have been motivated to add known flame retarding additives to the composition of Cavezzan in an effort to obtain the known benefits and properties associated therewith.

6. Claims 40 and 42 to 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takita et al.

These claims limit the composition to the mixture B, the polyorganosiloxane composition D (which is a mixture of Si-alkenyl and Si-H siloxanes) and, optionally, quartz. This does exclude the azo compound found in Takita et al. Applicants are reminded, however, that a reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including nonpreferred embodiments. Similarly, disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. In re Susi, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). "A known or obvious composition does not become

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patentable simply because it has been described as somewhat inferior to some other product for the same use.”

In the instant application, the only difference between these claims and comparative example 1 is that the silicone rubber therein is peroxide cured rather than hydrosilylation cured. Since the claimed composition is not specifically shown by Takita et al. the Examiner cannot establish if it was, in fact, known. However, the fact that Takita et al. teach that peroxide cure and hydrosilylation cure can be used in the alternative with the expectation of obtaining comparable results makes the difference between comparative example 1 and that claimed obvious.

As noted above, the Examiner is of the position that the composition in comparative example 1 demonstrates some degree of flammability, albeit not as good as that found in the compositions of Takita et al. As noted in column 1, the addition of platinum compounds per se is a known manner of making silicone rubbers nonflammable. Thus even though the composition in comparative example 1 is inferior to the compositions disclosed by Takita et al., this does not detract from the fact that the difference between a peroxide cured silicone rubber and an hydrosilylation cured silicone rubber would have been obvious, given the totality of the teachings in Takita et al.


7. Claims 30 and 34 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday to Wednesday and Friday, 10am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Margaret G. Moore
Primary Examiner
Art Unit 1712

mgm
4/10/06